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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/549,668

09/19/2005

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Q90317

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1788

NOTIFICATION DATE

DELIVERY MODE

12/09/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/549,668 | Applicant(s) SHOSHI, SATORU | |
| | Examiner ANISH DESAI | Art Unit 1788 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments in response to the Office action (OA) mailed on 06/25/10 have been fully considered and found persuasive. Support for new claim 10 is found in original claims, claim 1, and specification (e.g. paragraphs 0010, 0019, and 0070 in Pg Pub of this application for "consisting of" language in claim 10).

2. The 103(a) rejections to claims 1, 7, and 8 based on **Nagamoto et al. (US 6,156,423)** in view of Ebe Kazuyoshi et al. (JP 62-153376A) are withdrawn in view of applicant's amendment and response. Neither Nagamoto nor Ebe disclose "wherein the hard coat layer comprises at least one selected from the group consisting of a thermosetting hard coat agent of silicone hard coat agent and...acrylates." as claimed. Further, there is no reason to modify the prior art of Nagamoto (US'423) to arrive at the presently claimed invention given that Nagamoto discloses specific composition of the barrier layer (which was equated by the Examiner as a hard coating) that is outside the composition of the hard coat layer of the presently claimed invention, and Nagamoto does not teach or suggest presence of additional layers (e.g. hard coat layer).

3. Similarly, after reviewing applicant's arguments and amendment, the 103(a) rejections based on **Nagamoto et al. (US 6,139,953)** in view of Onozawa et al. (US 6,103,370) to claims 1, 4, and 7-9 are withdrawn. Specifically, it is noted that Nagamoto (US '953) does not teach or suggest or suggest presence of additional layers such as a

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hard coat layer in the PSA tape of his invention. As such, while the secondary reference of Onozawa discloses a hard coat layer as claimed; given that Nagamoto does not teach the presence and/or desirability of additional layers and the fact that Nagamoto's adhesive tape and Onozawa's hard coated sheet have different intended uses (e.g. see paragraphs 4-6 on page 7 of 09/27/10 amendment); there is no reason to add the hard coating layer of Onozawa in the invention of Nagamoto (US'953).

4. A new 112-first and second paragraph rejections are made in view of applicant's amendment to claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 3, 4, and 6-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

6. Regarding claim 1, said claim recites "wherein the hard coat layer comprises at least one selected from the group consisting of a thermosetting hard coat agent of

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silicone hard coat agent and an ultraviolet curable hard coat agent of (meth) acrylates, urethane (meth) acrylates or polyester (meth) acrylates." While there is support to recite that "wherein the hard coat layer comprises at least one selected from the group consisting of a thermosetting hard coat agent of silicone hard coat agent"; there is no support to broadly recite "an ultraviolet curable hard coat agent of (meth) acrylates, urethane (meth) acrylates or polyester (meth) acrylates". Specification (e.g. see paragraph 0035 in Pg Pub and claim 9) only provides support to recite an ultraviolet hard coat agent of a polyfunctional ultraviolet curable acrylic compound having three or more functional groups and is selected from the group consisting of acrylates, urethane acrylates and polyester acrylates. As such claim 1 is broader in scope than what is supported by the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 9 depends from claim 1. It is noted that claim 1 as amended requires specific hard coat agents. Claim 9 also recites specific hard coat agents. As such it is unclear whether the hard coat agents recited in claim 9 are additional hard coat agents.

Allowable Subject Matter

9. **Claim 10 is allowed based on the following reasons:** applicant has introduced language of “consisting of” with respect to the claim limitation of cured urethane (meth) acrylate layer. As such the cured urethane (meth) acrylate of the claimed invention excludes additional ingredients.

10. **The closest prior art to claim 10 is Nagamoto et al. (US 6,156,423) and Nagamoto et al. (US 6,139,953).**

11. Nagamoto (US'423) discloses an adhesive tape having a film layer that is formed of urethane (meth) acrylate oligomer and reactive diluent (column 4 lines 1-31). As such, the film composition of Nagamoto includes reactive diluent monomer (column 4 lines 28-30) which is excluded by claim 10 recitation “...wherein the **cured urethane (meth) acrylate layer** is formed by curing a curable composition **consisting of a difunctional urethane (meth) acrylate...**” Further, absent hindsight there is no reason to remove the reactive diluent monomer from the invention of Nagamoto (US'423).

12. Similarly, Nagamoto (US'953) discloses an adhesive tape wherein adhesive layer is coated on a base material. However, Nagamoto (US'953) discloses base sheet formed of urethane (meth) acrylate oligomer and reactive diluent (column 3 lines 15-25). As such, the film composition of Nagamoto includes reactive diluent monomer which is

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excluded by claim 10 recitation "...wherein the cured urethane (meth) acrylate layer is formed by curing a curable composition **consisting of a difunctional urethane (meth) acrylate...**" Further, absent hindsight; there is no reason to remove the reactive diluent monomer from the invention of Nagamoto (US'953).

13. Accordingly, claim 10 is allowable over the current prior art of record.

Response to Arguments

14. Applicant's arguments filed on 09/27/10 have been fully considered and are persuasive.

Conclusion

15. **The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

(1) Masaoka et al. (US 4,672,080) discloses photocurable resin prepared from urethane-acrylate oligomer resin.

(2) Yoshida et al. (US 2004/0126575A1) discloses a PSA sheet.

(3) Matsumura et al. (US 2005/0031861 A1) discloses a re-peelable PSA tape.

(4) Shoshi et al. (US 7,655,308 B2) discloses a film for optical applications.

(5) Yoshida et al. (US 2008/0193728 A1) discloses a PSA sheet.

(6) Janseen et al. (US 6,461,709B1) discloses graffiti and/or environmental protective article.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 9:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1788

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787